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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,110	02/11/2004	Shigeru Tago	HIRA.0143	3621

7590 04/17/2007
Reed Smith LLP
Suite 1400
3110 Fairview Park Drive
Falls Church, VA 22042-4503

EXAMINER

SKIBINSKY, ANNA

ART UNIT	PAPER NUMBER
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1631

MAIL DATE	DELIVERY MODE
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04/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/775,110

Applicant(s)

TAGO ET AL.

Examiner

Anna Skibinsky

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 February 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see continuation sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: 6 and 8.
Claim(s) rejected: 1, 3, 4 and 6-8.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see continuation sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.


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SUPERVISORY PATENT EXAMINER

Continuation of Item 3 NOTE:

The proposed amendments to claims 1, 4, 6 and 8 directed to a method of calculating the frequency of appearance of a keyword introduce new issues requiring further search and consideration. Further, the proposed amendments to claims 1 and 4 would introduce the substantive change of limiting the claimed method to "consisting" of the steps recited in said claims. Additionally, claims 1 and 4 recites new limitations such as "automatically and mechanically counting per document a number of extracted second documents" and "said key word table thereby showing numbers of documents including said keywords", which have not been previously presented. The amendments change the scope to the claimed invention and require a review of the prior art, which requires new search and consideration.

Continuation of Item 11 NOTE:


The rejections in the previous Office action mailed 11/29/2006 are maintained for reasons of record.

Claims 1, 2, 4, and 6-8 are rejected under 35 USC 103(a) as being unpatentable over Murray et al. in view of Getchius et al. Applicants arguments are directed to amendments to the instant claims which have not been entered onto the record.

Claims 6 and 8 were objected to for minor informalities. The proposed Final amendment, if entered, would be sufficient to overcome the objections to claims 6 and 8.

In the Remarks filed after-final (3/13/2007) Applicants argue that "Murray's 'journal titles'" are different from "key words of known functions or characteristics of genes or proteins". In response, this argument is not persuasive because Murray et al. teach the extraction of information from journal abstracts where a frequency score is then attached to journal titles. Here, the journal titles read on the limitation of being keywords of a known function or characteristic, as recited in claim 1, lines 13-15.

Applicants further argue (Remarks, page 8, lines 5-19) that Getchius, relied upon for a teaching of a tree structure, involves the viewing of a second database which is not intended in the instantly claimed invention. Further, that Getchius teaches a business listing. In response and as reiterated in the maintained rejection of record, the teaching of Getchius sets forth a database where data is organized in a tree structure. Ordering data in the form of a tree is a computational data structure well known in the art, as evidenced by the teaching of Getchius, and applicable to any form of data. Getchius teaches the need to organize data (col. 21, lines 5-6 and col. 33, lines 17-26).



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